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IN THE

Supreme Court of the United States

October Term 1943.

No. 455

LEROY J. LEISHMAN,

Petitioner,

vs.

ASSOCIATED WHOLESALE ELECTRIC COMPANY, a corporation,

Respondent.

PETITION FOR REHEARING.

JOHN FLAM,
914 Fidelity Building, Los Angeles,
Counsel for Petitioner.

Parker & Baird Company, Law Printers, Los Angeles

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PETITION FOR REHEARING.

Your petitioner respectfully requests that his petition for a writ of certiorari, denied December 6, 1943, be reconsidered because of the importance and far reaching effect of the principles of patent law involved—principles upon which this Honorable Court has never passed.

More succinctly stated, the question presented by the Ninth Circuit Court decision in the instant case, and posed in the original petition, are:

1. Can a court purposely delete a portion of the original patent before comparing it with the reissue to determine whether the two are for the same invention?

2. Is the Second Circuit Court of Appeals right in holding that reissue claims may omit an element not stressed as essential in the original patents, or is the Ninth Circuit Court of Appeals right in holding that the reissue is not for the same invention unless its

claims include all the specific elements that may be found in the original patent and claims, even though one of the elements was not stressed in the original patent as essential to the invention and was, in fact, omitted from one of the original claims?

Regarding the Matter of Deleting a Part of the Original Patent Before Making the Comparison.

In its decision in *U. S. Industrial Chemicals, Inc. v. Carbide and Carbon Chemicals Corp.*, 315 U. S. 668, this court reiterated the long established doctrine that whether a reissue is for the same invention as the original is to be determined by a comparison of the two documents themselves, and that "It must appear from the face of the instrument that what is covered by the reissue was intended to be covered by the original."

In purposely deleting a portion of the original patent before making this comparison, the Ninth Circuit Court of Appeals has done an unprecedented thing. Instead of judging what appears from the face of the two instruments as they issued from the patent office, the Appellate Court admittedly marred the face of the original patent and then concluded that the two documents did not look the same.

The Ninth Circuit Court did this as a result of a misinterpretation or misconception of this Honorable Court's decision in *Altoona Publix Theatres v. American Tri-Ergon Corp.*, 294 U. S. 477. In that decision, this court said that a disclaimer "speaks from the date of the original patent."

In using that statement as its authorization to construe the *original* patent as if it had never included claim 5

because it was later disclaimed from the reissue after the issuance of the letter, the Ninth Circuit Court of Appeals overlooked two important things about the *Altoona* decision:

a) The Supreme Court obviously meant that *so far as holding an infringer is concerned,* the disclaimer speaks from the date of the patent itself. The statement in the *Altoona* case cannot be applied to the matter of *original intent* and then construed to mean that the patentee never intended to make the disclaimed claim in the first place.

b) In its *Altoona* decision, the Supreme Court was dealing with an *original* patent, not with a *reissue.* The statement that the disclaimer "speaks from the date of the original patent" therefore meant that the disclaimer speaks from the date of the patent to which it is attached, and it did not mean that a disclaimer of a *reissue* claim must be applied to the original patent when resurrecting it to determine the patentee's *original* intent.

As pointed out in the petition and in the reply brief, the Ninth Circuit Court of Appeals in the instant case cited the *Altoona* decision as authority for construing the original patent as if it had never included claim 5, which was confined to the essential elements of the invention and did not include a lever. Based upon its deletion of this claim and summing up its consideration of the *other* original claims, the Ninth Circuit Court of Appeals was able to say: ". . . the claims of the original patent are for combinations each of which includes a lever or levers.[13]" Its footnote 13, here referred to, analyzed claims 1, 2, 3, 4 and 6, and ignored claim 5 for the reasons

which the decision had previously explained, and which are here complained of. The Court of Appeals then concluded: "If they (the reissue claims) do not include levers, the claims are not for the same invention as the original patent and hence are invalid." (Citing the Supreme Court *U. S. Industrial Chemicals* decision.)[1]

This misapplication of the *Altoona* decision is a very serious one. As long as it stands uncorrected, no patentee can safely disclaim a broad claim from a reissue patent that appears in his original patent without placing the validity of his reissue patent in jeopardy.

If the disclaimed reissue claim must be stricken from the original patent when comparing the two documents to determine whether they are for the same invention,

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[1]Respondent's brief urged that the petition should not be granted on the ground that the decision would have been the same even if claim 5 had been considered. To support this contention, respondent misconstrued the claim in its brief. That respondent's interpretation cannot be reconciled with the language of the claim was thoroughly brought out in petitioner's reply brief (pp. 4-5), to which reference is respectfully requested.

Even had the Circuit Court interpreted claim 5 in the manner recommended by the respondent, the consideration of this claim nevertheless would have avoided the holding that respondent's plunger is not the equivalent of petitioner's lever, for the only reason the court assigned for this holding was that respondent's plunger operates only one tappet whereas petitioner's lever operates two. No matter what genius respondent may show in misconstruing claim 5, it cannot import two tappets into the claim, nor two rockers. A consideration of this claim, even as misinterpreted by the respondent, would thus have shown that petitioner intended his invention to be used with a single tappet and rocker "to tune in either a radio set or a television set," as set forth in the objects. No distinction between the lever and plunger as equivalents could then have been drawn.

For further information on this point, the court is respectfully referred to pages 5, 6, 7 and 8 of petitioner's reply brief, including especially the last half of the footnote on page 6.

then such deletion, as in the instant case, the two documents will of course be dissimilar on their face. The presence of a broad claim in an original patent constitutes most excellent evidence of the patentee's intention to claim his invention broadly without tying himself down to the exact embodiment shown, and therefore should not be ignored. Particularly is this true if the claim is drawn to the essential elements of the invention *per se* without including auxiliary parts in which the essence of the invention does not lie.

The Supreme Court granted petitioner's request for a writ of certoirari in this case on a previous occasion because of the possible consequences of the decision of the Ninth Circuit Court of Appeals to the effect that a motion under Rule 52 (b) did not extend the time for filing an appeal. The question now presented is much more serious in its possible effect upon future litigants than the earlier one involving Rule 52 (b). Had the Ninth Circuit's holding regarding this rule not been reversed, future litigants could appeal within three months of the original judgment; but future litigants have no alternative by which to escape the consequences of the Ninth Circuit's latest decision in this case. Hundreds of reissue patents that duplicate certain original claims are now in force, and others will be granted in the future. When it becomes necessary to disclaim from any of these reissues one of the broad claims carried over from the original patent, the patentee in every such instance will be faced with a dilemma that cannot be resolved. If he disclaims the claim, it will "speak from the date of the original," and the construing of the original as if the claim had never been included will make it appear that the patentee had no intention of making a broad claim in the original

patent; and the presence of other broad claims properly not disclaimed from the reissue will bespeak a different invention from the artificially construed original document, with the result that the reissue will be invalid. So on this ground it would appear that he should not enter the disclaimer. Yet if he does not disclaim the broad claim to which he has found he is not entitled, his patent will be invalid through failure to disclaim, for it has been uniformly held by the courts that such failure invalidates the whole patent.

This decision of the Ninth Circuit Court of Appeals thus makes it unsafe for any patentee to disclaim from a reissue patent any broad claim that has appeared in the original.[2]

And there is nothing hypothetical or suppositional about this statement. In the instant case, all the patentee's rights to any invention that resided in his rocker and tappet elements and their relationships *per se*, have been wiped away by the Appellate Court. This was done by its holding that as a result of his disclaimer of claim 5 from the reissue patent, the claim must be deleted from the original patent also, for the court used this deletion to reach its conclusion that the patentee never intended to claim any invention in respect to these essential elements unless they were operated by a lever, and that if the

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[2]It might be suggested that he obtain a second reissue, in order to rid himself of the unwanted claim. But this cumbersome method is a poor substitute for the expeditious remedy provided by the disclaimer statute. If disclaimer statute should thus be limited, then the Supreme Court should pass upon the point. On the other hand, if the disclaimer method is proper, the 9th Circuit Court of Appeals should be reversed.

reissue claims "do not include levers, the claims are not for the same invention as the original patent."

The instant decision of the Ninth Circuit Court of Appeals thus not only makes it possible to place an artificial interpretation upon a patentee's original intent, but also creates a situation that is incompatible with a patentee's statutory right to disclaim. Surely this state of affairs justifies the granting of the petition for a writ of certiorari.

But there are yet other grounds for such action.

The Conflict With the Decision of the Second Circuit Court of Appeals Confuses the Law With Respect to Reissues.

The conflict between the instant decision and the cited decision of the Second Circuit Court of Appeals involves interpretations of this Honorable Court's decision in the *U. S. Industrial Chemicals* case that broadly affect the reissue statute and the whole doctrine with respect to reissue patents.

In *Milcor Steel Co. v. George A. Fuller Co., et al.*, 316 U. S. 143, this Honorable Court said at page 144: "We granted certiorari . . . because of an alleged conflict with decisions on the question in other circuits," the alleged conflict being with the *Payne Furnace* decision of the Ninth Circuit. As in the instant case, the same patent was not involved in both circuits, but the petition was granted because of the importance of the doctrine concerned.

The instant conflict is far more than an alleged one. There is an actual conflict on an important point of law. If the Ninth Circuit interpretation of the Supreme Court's *U. S. Industrial Chemicals* decision is to prevail, then—

a) No patentee can safely obtain a reissue containing claims limited to the essential elements of his invention.

b) The right to obtain a broadening reissue, clearly permitted by the statute, will be nullified.

In *Monogram Mfg. Co. v. Glemby Co., Inc.*, 136 F. (2d) 961, the Second Circuit Court of Appeals followed the Supreme Court's decision in the *U. S. Industrial Chemicals* case, and made the omission of an element from the reissue contingent upon whether the element had been stressed as essential in the original patent.

In the instant case, the decision of the Ninth Circuit Court of Appeals that applicant's reissue claims are not for the same invention unless they include levers, was not in any way made contingent upon any statement in the original patent that the lever was an essential part of the invention. The court merely pointed out that the invention is not shown nor described without a lever, and that if claim 5 is ignored, all the remaining claims include levers. The court then erroneously concluded that the reissue claims must therefore include levers in order to be valid.

Broadening reissues[3] are obtained by omitting from the claims elements that were included in the original claims but which are not a part of the invention *per se*. *If the Ninth Circuit, instead of the Second Circuit, is to be followed, this can no longer be done.*

As a result of the conflicting opinions between these two circuits, the law is confused; and no one knows now whether elements that are not a part of the invention *per se* can be omitted from reissue claims, nor is it certain whether broadening reissues are still permissible.

Petitioner urges that the Supreme Court should remove this uncertainty.

This conflict between circuits constitutes a second reason, totally independent of the first, why the petition for a writ of certiorari should be granted.

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[3] If claim 5 is considered as having been a part of the original patent, the instant reissue is not a broadening one, for no operating element of any kind was included in the claim. The qualifying limitations added to the language of claim 5 in claims 7 and 8 serve to narrow the claim, as does the addition of an operating member in claims 9, 10 and 11. If the patentee's original intention is supposed to be judged by pretending that claim 5 was never a part of the original patent, then the matter of whether the present reissue is a broadening or a narrowing one would have to be determined by comparing the other original claims with those added in the reissue. However, the matter of whether the present reissue is a broadening or a narrowing one is of no moment in the present case.

Additional Informal Grounds.

The two grounds on which the petition was based, and which have been more fully discussed herein, are of course within the scope of Rule 38 of this Honorable Court. However, this Court has, on occasion, reviewed Circuit Court patent decisions for reasons not within the rule when it has appeared impractical for the patentee to secure a decision in another circuit within the forseeable future, if at all.[4] In the present case, there are two reasons of a similar nature why the petition should be granted.

Although petitioner believes that the grounds already stated are of more than sufficient importance and seriousness to justify the granting of the petition, it may be well here to discuss the special reasons why the instant petitioner should not be required to await a decision on this same patent by another circuit.

The First Special Reason.

In the year 1938, the reissue patent involved in this suit was widely infringed. That very year, your petitioner filed the present suit against the respondent, a jobber for the Crosley Corporation, the first infringer [R. Vol. I, p. 5]. Petitioner was unable to get the suit placed on the calendar until the spring of 1940, and then, at the request of the judge to whom the case was assigned, both litigants consented to have the case put over until the

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[4]*Mackay Radio and Telegraph Company, Inc. v. Radio Corporation of America,* 306 U. S. 86; 59 S. Ct. 427; 83 L. Ed. 506.

Paramamount Publix Corporation v. American Tri-Ergw Corporation, 294 U. S. 464; 55 S. Ct. 449; 79 L. Ed. 997.

fall term. The case came to trial on October, 1940, and the opinion is dated January 29, 1941 [R. Vol. I, p. 32]. The decision was appealed; but as this Honorable Court knows, the appeal was dismissed for reasons which this court held to be "artificial and untenable." As a result of this delay, the Circuit Court decision was not rendered until August of this year, 1943. If your petitioner now has to await a decision from another circuit in another suit, the statute of limitations will render it impossible to make the ultimate decision effective against still other 1938 infringers.

On only one occasion has your petitioner been responsible for any delay during the five-year period that has elapsed since the present suit was brought, and that was a ten-day delay necessitated because of counsel's absence from the city in connection with another case. Your petitioner has thus shown diligence in protecting his patent rights, yet he has gotten only this far; and he should not be required to begin all over again and have his rights to recover wiped away in the meantime by the statute of limitations. It might be suggested that there is yet time to file these suits. This is probably true, but the courts now insist that such cases be tried promptly, and it would be out of the question to do that, as there are almost a score of 1938 infringers in various circuits.

Secondly, Petitioner Has Never Had a Chance to be Heard on the Points Now Decided Against Him.

The second reason that is peculiar to the present case involves the obvious right of any litigant to be heard on any grounds on which a case is decided against him. The ground that the reissue claims in suit are not for the same invention as the original patent unless they include levers, was never advanced by anyone until the Circuit Court advanced it in its decision.[5] The contributory argument that an original claim that has been disclaimed from the reissue cannot be taken into consideration when examining the original patent to determine what the patentee intended to cover, was likewise never raised until this last Circuit Court decision was rendered. Your petitioner has thus had no chance to be heard on either of these points. If the Supreme Court does not grant the petition, the instant litigant, five years after the filing of his suit which has been diligently prosecuted, will have had his claims against the respondent wiped away on grounds on

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[5]It is true that respondent urged the stock defense against reissue patents that the reissue was not for the same invention as the original, but respondent based this defense upon the fact that petitioner added to his reissue claims the limitation that the tappet and rocker must be shaped and arranged so that the axis of the one is coaxial with the axis of the other in the tuned-in position. This feature was shown in the original drawings and disclosed in the original specification, and language directed to structural features that attain this coaxiality was included in certain of the original claims. The Court of Appeals did not hold with the defendant on this score, but advanced a totally new ground for contending that the reissue was not the same invention—namely, that the reissue claims must include levers in order to be valid. This ground was not included in the defenses raised by the respondent; it was never raised by the District Court; it was never raised in any brief until after the Circuit Court rendered its decision; and it was never raised by the Circuit Court in any hearing.

which he has never been given an opportunity to be heard. This is hardly in keeping with American ideals of justice. But the injustice can be removed by the exercise by this court of its discretionary powers.

Your petitioner thus earnestly urges that his petition should be reconsidered and granted.

Respectfully submitted,

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JOHN FLAM,

Counsel for Petitioner.

Certificate.

This petition for rehearing is presented in good faith and not for delay.

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JOHN FLAM,

Counsel for Petitioner.